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| 08/828,330 | 03/28/1997 | WILLIAM D. MORGAN | LAEC:007USR1 | 4766 |
| 33425 7590 05/11/2009 FULBRIGHT & JAWORSKI L.L.P. 600 CONGRESS AVE. SUITE 2400 AUSTIN, TX 78701 | | | | |
| EXAMINER | | | | |
| CANFIELD, ROBERT | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

08/828,330

Applicant(s)

MORGAN, WILLIAM D.

Examiner

ROBERT J. CANFIELD

Art Unit

3600

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11, 12, 14, 19, 20, 22, 50-56, 59-64 and 66-78 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-4 is/are allowed.
- 6) ☒ Claim(s) 5-9, 11, 12, 14, 19, 20, 22, 50-56, 59-64 and 66-78 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 August 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☒ Other: Copy of Assignment

1. This Office action is in response to the amendment filed 08/18/08. Claims 1-9, 11, 12, 14, 19, 20, 22, 50-56, 59-64 and 66-78 are pending. Claims 10, 13, 15-18, 21, 23-49, 57, 58 and 65 have been canceled.
2. Applicant is reminded of the continuing obligation under 37 CFR 1.178(b), to timely apprise the Office of any prior or concurrent proceeding in which Patent No. 5,400,549 is or was involved. These proceedings would include interferences, reissues, reexaminations, and litigation.

Applicant is further reminded of the continuing obligation under 37 CFR 1.56, to timely apprise the Office of any information which is material to patentability of the claims under consideration in this reissue application.

These obligations rest with each individual associated with the filing and prosecution of this application for reissue. See also MPEP §§ 1404, 1442.01 and 1442.04.

3. Claim 22 is objected to because of the following informalities:
In claim 22, "the tie-down cable" should read "the at least one tie-down cable"
Appropriate correction is required.
4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 19, 20, 22, and 54 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim elements “means for anchoring the cover” and “means for anchoring the tie-down cable” are means plus function limitations that invokes 35 U.S.C. 112, sixth paragraph. However, the written description fails to clearly link or associate the disclosed structure, material, or acts to the claimed function such that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function. The specifications fails to expressly recite what the structure is which performs the claimed function

Applicant is required to:

- (a) Amend the claims so that the claim limitation will no longer be a means (or step) plus function limitation under 35 U.S.C. 112, sixth paragraph; or
- (b) Amend the written description of the specification such that it clearly links or associates the corresponding structure, material, or acts to the claimed function without introducing any new matter (35 U.S.C. 132(a)); or
- (c) State on the record where the corresponding structure, material, or acts are set forth in the written description of the specification that perform the claimed function. For more information, see 37 CFR 1.75(d) and MPEP §§ 608.01(o) and 2181.

6. Claims 5-9, 11, 12, 14, 19, 20, 22, 50-56, 59-64 and 66-78 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 4,590,714 to Walker in view of U.S. Patent 4,038,447 to Brock and in further view of Applicant's admitted prior art.

Walker provides a plurality of rectangular panels comprised of high density polyethylene material considered a "geomembrane" [col 1, lines 41-42 of applicant's disclosure], membranes 1 and 2 having a compressible insulating material 3 therein. As the insulating material is a compressible batt it is considered not to completely fill the membranes. The membranes are provided with stitched seams 41 and 42 along their perimeters. The panels are provided with a plurality of openings in the form of grommets 41 spaced apart from the edges of the panels as shown in figure 2. Figure 3 shows how the openings of one panel are positioned above the openings of an adjacent panel such that a fastener can be passed through the openings. The panels are disclosed as being capable of being joined with removable fasteners passed through grommets for use as a covering.

Walker fails to provide that the seams 41 and 42 are sealed.

Brock teaches that at the time of the invention heat seals or fused portions 219 [considered to meet the limitation of a weld] were a known equivalent means to stitched seams 119 for joining membranes of a covering material.

It would have been obvious at the time of the invention to one having ordinary skill in the art that the stitched seams 41 and 42 of Walker could have been replaced with heat seals as taught by Brock at 219. It would have been nothing other than the

obvious substitution of one known means of providing a joined seam for another known equivalent known means. Further there would have been no unexpected or unpredictable results obtained by using a heat seal in lieu of stitching.

Walker also fails to teach or suggest that the covering panels are positioned over wastewater that includes sewage and/or industrial waste.

Applicant admits in the Summary and Background of the Invention that providing geomembrane covering systems over wastewater was known at the time of the invention.

It would have been obvious at the time of the invention to one having ordinary skill in the art that the geomembrane covering system taught by Walker as modified by Brock could have been used to cover wastewater as Walker teaches that his system is design to cover and protect an underlying structure or material and the use of geomembrane covering systems over wastewater was known at the time of the invention. There would have been no unexpected or unpredictable result achieved from using the known covering system of Walker as modified by Brock in an environment where it was known to be desirable to provide a cover. One of ordinary skill in the art would have recognized that the covering system of Walker could have been placed in direct contact over wastewater.

The dimensions claimed in claim 8 are viewed as nothing other than a choice of design which would have been obvious at the time of the invention to one having ordinary skill in the art. It would have been obvious at the time of the invention that panels of Walker could have been sized as desired/required. Further, it has been held

that where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

The D ring or loop shown as part of the fastener in Figure 3 of Walker is considered to meet the limitation of "means for anchoring" in claims 19 and 54.

While Walker fails to show his panels tied down with cable anchoring means he does suggest in the background of the invention that it was well known at the time of the invention to hold panels down with ropes. This would suggest to one having ordinary skill in the art that Walker had intended his panels to be tied or anchored down with cables such as ropes through the grommets and loops of the fastening device shown in figure 3.

The fasteners shown in figure 3 of Walker are inherently removable and thus adjacent panels inherently can be all of: removably linked, linked, de-linked, and re-linked.

While not relied upon in the above rejections, as not deemed necessary to meet the claims, note that Brock also shows in figures 6 and 7 insulating material 121/221 contained within but not completely filling his panels to the same extent as the instant applications figure 1.

7. Claims 56 and 59-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 4,038,447 to Brock in view of U.S. Patent 4,590,714 to Walker.

Brock provides a covering comprised of outer sheet members 216 and 217 of a plastic film having an insulating core 221 sealed therein. Figure 7 shows the core does not fill completely fill the panels to the same extent applicant's application supports this limitation. Brock also provides openings or grommets 120 spaced apart from the edges of his panels.

Brock fails to provide that the outer sheet members are formed of high density polyethylene and that a plurality of the panels may be removably linked by fasteners disposed through overlapping openings or grommets of adjacent panel portions.

Walker teaches at the time of the invention it was known that the outer sheets of a covering formed from plastic sheets and an insulating core could have been made from high density polyethylene.

It would have been obvious at the time of the invention to one having ordinary skill in the art that the outer sheets of Brock could have been made from high density polyethylene as taught by Walker. It would have been obvious to take advantage of the inherent material properties. Further, it would have been nothing other than the substitution of one known plastic sheet for another known plastic sheet without any unpredictable results.

Walker further teaches that at the time of the invention it was known to removably connect adjacent coverings provided with grommets at their edges by overlapping the opening and providing a removable fastener there through (figure 3). It would have been obvious at the time of the invention to one having

ordinary skill in the art that the panels of Brock could have been removably fastened to one another by overlapping openings or grommets on adjacent edges and passing a removable fastener there through as taught by Walker. It would have been nothing other than using a known means of allowing adjacent panels to be removably fastened to one another so as to increase the size of the covering.

8. In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed.

Claims 5-9, 11, 12, 14, 19, 20, 22, 50-56, 59-64 and 66-78 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251. See 37 CFR 1.175.

Receipt of an appropriate supplemental oath/declaration under 37 CFR 1.175(b)(1) will overcome this rejection under 35 U.S.C. 251. An example of acceptable language to be used in the supplemental oath/declaration is as follows:

"Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant."

See MPEP § 1414.01.

9. Applicant's arguments filed 08/18/08 have been fully considered but they are not persuasive.

The declaration under 37 CFR 1.132 filed on 08/18/08 is insufficient to overcome the rejection of claims based upon Walker as set forth in the last Office action because:

10. Applicant's argument that Walker's tarp would take on water if placed over wastewater because the seams are stitched together and thus not sealed is not commensurate with the scope of the claims and disclosure and is not persuasive in view of the new grounds of rejections where the secondary reference Brock clearly teaches heat seals 219 and also teaches the equivalence of heat seals 219 and stitching 119 for seams of composite panels comprised of plastic outer membranes and insulating cores. Also note that Walker recites "sealed" at column 3, line 19. Thus the panels of Brock and the panels of Walker as modified by Brock are considered to meet the limitation of "sealed" particularly when substituting the heat seals 219 of Brock for the stitched seams of Walker. There is no description provided in the original disclosure to how the panels are sealed or to what extent the panels are sealed. There is certainly no support that the panels are sealed such that they are watertight. The original disclosure only states that each casing is filled with a layer of insulation and then sealed at either end and along either side by a fusion weld.

Applicant further argues that Walker's tarp is not sealed as it includes a vent on its top. This is not persuasive as the limitation of sealed is considered met by using heat seals at the seams of Walker.

An argument that Brock does not teach sealed panels because of passages 226 would not be found persuasive as Brock clearly teaches using heat seals or fused portions 219 to secure together sheet members and this is considered to meet the limitation of sealed.

The examiner acknowledges that the postcard filed on March 14, 2006 shows that an Assignment filed. The examiner cannot find a copy of the assignment in the electronic record and has attached a copy of the assignment from the Patent Office records

11. Claims 1-4 remain allowed.

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent 3,420,022 to Brock teaches a water impervious insulation panel.

US Patent 4,780,351 to Czempoyesh with teaches rectangular blankets with grommets 6.

US Patent 5,652,972 to Chartrand teaches rectangular insulated panels with grommets 40.

13. Any inquiry concerning this communication should be directed to ROBERT J. CANFIELD at telephone number (571)272-6840.

Robert J Canfield
SPE
Art Unit 3635

/Robert J Canfield/

Supervisory Patent Examiner, Art Unit 3635